

ESTTA Tracking number: **ESTTA628834**

Filing date: **09/23/2014**

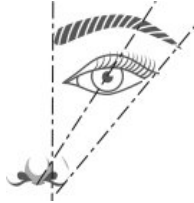
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Attachments	Opposition to Applicant's Motion for Judgement on the Pleadings (F1532780x96B9E).pdf(298221 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of: Application Serial Nos. 86/150,772 and 86/150,767

Mark:



BENEFIT COSMETICS LLC,

Opposer,

v.

ANASTASIA BEVERLY HILLS, INC.,

Applicant.

Opposition No. 91216907

OPPOSITION TO APPLICANT'S MOTION
FOR JUDGMENT ON THE PLEADINGS

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Opposer Benefit Cosmetics LLC (“Opposer”) submits this memorandum in opposition to the Motion for Judgment on the Pleadings (the “Motion”) filed by Applicant Anastasia Beverly Hills, Inc. (“Applicant”).

I. INTRODUCTION

Opposer brought this opposition proceeding against Applicant’s applications, Serial Nos. 86/150,772 and 86/150,767 (the “Applications”), to register the above design mark (“Applicant’s Proposed Mark”) for “Tweezers” in International Class 8 and “Stencils for use in applying makeup and shaping the eyebrow” in International Class 16. Opposer opposes Applicant’s Applications on multiple grounds: (1) that Applicant’s Proposed Mark, an informational illustration of how to use the goods named in the Applications, fails to function as a trademark; (2) that Applicant’s Proposed Mark is functional and reflects a particular utilitarian brow-shaping technique or method; and (3) that Applicant’s Proposed Mark is merely descriptive of the use and function of the goods for which Applicant seeks to register the Proposed Mark.

After the parties’ mandatory discovery conference, in which the Board participated at Applicant’s request, Opposer served discovery requests. In a blatant attempt to avoid discovery, Applicant then filed the instant Motion, futilely relying on a series of misstatements of fact and law. *First*, Applicant argues that Applicant’s Proposed Mark functions as a trademark because Applicant’s Proposed Mark is purportedly a logo and “logos are not informational.” (Mot. 10-11.) Applicant’s conclusory argument is doubly wrong—there is no evidence in the record that Applicant’s Proposed Mark functions as a logo, and, in any event, there is ample Board precedent finding proposed logos to be informational and unregistrable. As Opposer argues in its Notice of Opposition, Applicant’s Proposed Mark is an informational illustration intended to demonstrate the use of the goods for which Applicant seeks to register the Proposed Mark.

Second, Applicant challenges Opposer's claim that Applicant's Proposed Mark is functional by arguing that Applicant's Proposed Mark cannot be functional because it is not trade dress. Here, again, Applicant misstates the facts and the law. There is nothing in the record to indicate that Applicant's Proposed Mark is not trade dress. Moreover, even if Applicant were later able to prove that its Proposed Mark is not trade dress, that would be entirely immaterial. It is well-established, including in the text of the Lanham Act itself, that alleged marks that are not trade dress can be functional and can be denied registration as a result. *See, e.g.*, 15 U.S.C. § 1052(e). *Finally*, Applicant challenges Opposer's descriptiveness claim with yet another non sequitur, arguing that Applicant's Proposed Mark cannot be descriptive because it does not depict the applied-for goods. Here, Applicant ignores black letter law that an alleged mark will be found descriptive if it depicts information concerning any significant function, purpose or use of the goods or services. Applicant's Proposed Mark describes the function, use, *and* purpose of the goods for which Applicant seeks registration of the Proposed Mark. As such, it is descriptive.

In sum, Applicant's incorrect statements of fact and law are insufficient to overcome Opposer's well-pleaded allegations in support of its Opposition to the registration of Applicant's Proposed Mark. Applicant's Motion should be denied.

II. STATEMENT OF RELEVANT FACTS

A. Opposer's Notice of Opposition

As alleged in the Notice of Opposition, Opposer is a world-famous cosmetics company that offers "a variety of brow-grooming services and products across the United States and throughout the world." (Notice of Opposition ("Not. Opp.") ¶¶ 1, 2.) "Opposer's brow grooming and shaping services and products are a core part of its business." (Not. Opp. ¶ 6.) In particular, as Opposer alleged, Opposer has long employed "a variety of brow-mapping

techniques to determine the ideal points at which the client’s eyebrow should begin, reach its highest arch, and end. In connection with these techniques, Opposer has developed and used brow-mapping diagrams and illustrations that use imaginary lines to identify these points by reference to a person’s nose, eyes and eyebrows.” (Not. Opp. ¶ 7 & Ex. A.)

Moreover, as Opposer additionally alleged, “[b]row-mapping diagrams and illustrations” of the type used by Opposer “are ubiquitous in the beauty industry and are widely used by estheticians and cosmetologists and in cosmetology schools and training materials.” (Not. Opp. ¶¶ 8, 14 & Ex. B.) “Such brow-mapping diagrams are didactic devices that show estheticians how to shape eyebrows.” (Not. Opp. ¶ 14 & Ex. C.)

In opposing Applicant’s Applications, Opposer alleged that Applicant’s Proposed Mark does not meet the requirements for registration as a mark under Sections 1, 2 and 45 of the Lanham Act because, much like the similar didactic devices used by others in the industry, it is merely informational in nature and serves no source-identifying function. (Not. Opp. ¶¶ 29, 31.) Opposer further alleged that Applicant’s Proposed Mark is functional and utilitarian, reflecting a particular brow-mapping technique or method, and that registration of this functional method would cause significant harm to Opposer and others in the beauty industry. (Not. Opp. ¶¶ 25, 26, 27.) Finally, Opposer alleged that Applicant’s Proposed Mark is merely descriptive of the goods for which Applicant seeks to register the mark, and thus unregistrable under Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1). (Not. Opp. ¶¶ 29, 30.)

III. ARGUMENT

A. Legal Standards

Pursuant to the Trademark Rules of Practice and the Federal Rules of Civil Procedure, a notice of opposition must only “set forth a short and plain statement showing why the opposer

believed he, she or it would be damaged by the registration of the opposed mark and state the grounds for the opposition.” 37 C.F.R. § 2.104(a); *see* Fed. R. Civ. Proc. 8(a). “The elements of a claim should be stated simply, concisely, and directly. However, the pleading should include enough detail to give the defendant fair notice of the basis for each claim.” Trademark Trial and Appeal Board Manual of Procedure (“TBMP”), §309.03(a)(2) at 300-144.

A motion for judgment on the pleadings under Federal Rule of Civil Procedure 12(c) may be granted only when the material facts are not in dispute and judgment on the merits can be achieved by focusing on the pleadings. *Leeds Techs. Ltd. v. Topaz Commc’ns Ltd.*, 65 U.S.P.Q.2d 1303, 1305 (T.T.A.B. 2002); *see also Chatam Int’l Inc. v. Abita Brewing Co.*, 49 U.S.P.Q.2d 2021, 2022 (T.T.A.B. 1998). For purposes of the motion, all well-pleaded factual allegations of the nonmoving party are assumed to be true, and the inferences drawn therefrom are to be viewed in a light most favorable to the nonmoving party. *Leeds Techs.*, 65 U.S.P.Q. at 1305. Therefore, a motion for judgment on the pleadings will only be granted when the moving party establishes that no material issue of fact remains to be resolved and that it is entitled to judgment as a matter of law. *Id.*

When a movant submits evidence outside the pleadings on a motion made under Rule 12(c), as Applicant has here, the Board must either exclude those matters or treat the motion as one for summary judgment. *See* TBMP § 504.03; Fed. R. Civ. P. 12(d). In this situation, summary judgment would be inappropriate, as Opposer has not been given any opportunity to pursue discovery—indeed, Applicant’s Motion is an obvious tactical maneuver to avoid discovery. *See Dunkin’ Donuts of Am., Inc. v. Metallurgical Exoproducts Corp.*, 6 U.S.P.Q.2d 1026, 1027-28 (Fed. Cir. 1988). Accordingly, the Board must exclude the matters outside the record introduced by Applicant as part of its Motion.

B. Opposer Has Sufficiently Pleaded Its Claim That Applicant's Proposed Mark Fails to Function as a Mark

As alleged in the Notice of Opposition, “[t]he diagram that composes Applicant’s Proposed Mark is merely informational in nature, does not uniquely identify Applicant’s goods or services, and is incapable of serving any source-identifying function.” (Not. Opp. ¶ 29.) Applicant’s chief argument to dismiss this claim is that its Proposed Mark is purportedly a “Logo,” and “[l]ogos are not informational.” (Mot. 11.) This conclusory claim is factually incorrect and legally irrelevant and should be rejected by the Board.

“To be a mark, the [asserted mark] must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods.” *In re Volvo Cars of N. Am. Inc.*, 46 U.S.P.Q.2d 1455, 1459 (T.T.A.B. 1998). But the applicant’s intent is not enough. *See In re Manco Inc.*, 24 U.S.P.Q.2d 1938, 1942 (T.T.A.B. 1992). Rather, in a “failure to function” case, “[a] critical element in determining whether matter sought to be registered is a trademark is the impression the matter makes on the relevant public.” *In re Brass-Craft Mfg. Co.*, 49 U.S.P.Q.2d 1849, 1852 (T.T.A.B. 1998). Put another way, “the critical inquiry is whether the asserted mark would be perceived as a source indicator.” *Id.* Thus, the fact that an asserted mark “appears on the specimens, even separate and apart from other indicia which appear on them, does not make it a trademark.” *Volvo*, 46 U.S.P.Q. at 1459. Moreover, “the mere addition of the trademark symbol is not sufficient to transform the non-trademark use into trademark use.” *In re Aerospace Optics, Inc.*, 78 U.S.P.Q.2d 1861, 1864 (T.T.A.B. 2006). As such, Applicant’s use of the TM symbol on its specimen is irrelevant. *Id.*; *see also In re Remington Prods.*, 3 U.S.P.Q.2d 1714, 1715 (T.T.A.B. 1987).

Marks of all types that merely convey instructions or information regarding a product’s use are not source-indicating and do not function as trademarks. *See In re H. Goodman & Sons*,

Inc., 135 U.S.P.Q. 407, 408 (T.T.A.B. 1962). As the Board explained in *H. Goodman & Sons*, where the applicant sought to register a design mark consisting of a woman brushing her hair upwards for “hair foundations for beehive hairdo,” a mark will be deemed informational if it is an “*illustration of the manner in which applicant’s product is used*,” even if does not show the product itself. 135 U.S.P.Q. at 408 (emphasis added). Indeed, “[i]t is well established that an . . . illustration of the manner of use of a product without more can afford no basis for an inference that it or any part of it is intended to be or would be recognized by purchasers as a trademark for the product.” *Id.*; see also *In re Sun-land Garden Prods., Inc.*, Serial No. 75/714,956, 2003 WL 21486433, at *3 (T.T.A.B. June 23, 2003) (holding that “applicant’s asserted mark”—which consisted of an illustration of a flower—“is not likely to be perceived as a mark for its mulch because it is used merely as informational matter advising purchasers of an intended use of the product”); *In re Int’l Spike, Inc.*, 196 U.S.P.Q. 447, 448, 449 (T.T.A.B. 1977) (refusing registration to a mark illustrating manner of use of “tree fertilizer sticks” and noting that it was “manifestly applicant’s intention to use the illustration of the tree, the circle, the spikes and the man hammering a spike into the ground to demonstrate the proper use and application of the goods”).

Applicant also makes an unsupported claim that its asserted mark is a “logo”—a claim that does not appear anywhere in the pleadings and, as such, cannot be considered on this Motion. Even if Applicant’s claim were part of the pleadings (which it is not), a mark need not be a “slogan or a term” or a “word mark” in order to be deemed informational. (*See* Mot. 10.) As the Board stated in *International Spike*, the law relating to failure to function “is just as applicable to pictures and illustrations as it is to words.” 196 U.S.P.Q. at 449 (denying registration to a proposed mark consisting of an illustration of a man hammering a spike into the

ground for tree fertilizer sticks on basis that mark failed to function); *see also In re Cotto-Waxo Co.*, 127 U.S.P.Q. 168, 169-70 (T.T.A.B. 1960) (denying registration to a proposed mark consisting of a broom sweeping a dark area for floor sweeping compounds because “[t]he design in question is clearly illustrative of the manner in which applicant’s compounds are used”); *In re Dunn-Edwards Corp.*, Serial No. 76/201,822, 2004 WL 3060188, at *1, *3 (T.T.A.B. Dec. 16, 2004) (denying registration to proposed mark consisting of a black paintbrush with the bristle portion stylized as black bricks with white cement for “paint for use on masonry” because the design “functions merely as an informational icon” and not as a trademark); *In re Signs Plus, New Ideas-New Tech., Inc.*, Serial No. 76/225,929, 2003 WL 23305944, at *1, *6 (T.T.A.B. Feb. 19, 2003) (denying registration to a proposed mark consisting of an apple with “A+” written on it for “non-luminous signs, non-mechanical metal signs, metal numbers and letters with means for temporarily affixing to the signs” because the design “merely informs potential purchasers the establishment is a school” and “does not function as a trademark for applicant’s goods”).

In this case, Opposer has alleged that Applicant’s Proposed Mark is an instructional illustration to direct consumers on the use and purpose of the products for which Applicant seeks to register the Proposed Mark, namely, “Tweezers” and “Stencils for use in applying makeup and shaping the eyebrow,” and is simply a didactic diagram that is virtually identical to many others in everyday use in the beauty industry (*see* Not. Opp. ¶¶ 7, 8, 13, 29); *see also In re Sun-Land*, 2003 WL 21486433, at *1 (affirming Examining Attorney’s denial of registration on the basis that the proposed design mark “merely provides information to the consumers concerning the use of applicant’s products”). If these allegations are taken as true—as they must be on this Motion—then, as in the cases cited above, Applicant’s Proposed Mark would not be considered a source-identifier and cannot be registered.

As an example of the didactic nature of Applicant's Proposed Mark, Opposer attached to the Notice of Opposition a printout from Applicant's website in which Applicant explains its "discovery" of its brow-mapping method and creation of stencils to apply the method:

[Applicant] discovered the easiest way to balance every face was through applying the Golden Ratio to the brows. Her signature technique calculates the exact starting and ending points in conjunction with the ideal arch for each individual face. These three points are the first step in creating symmetry and proportion in the features. *Following her dream to make this system accessible for everyone, Anastasia created a set of five patented Stencils that demonstrate the ideal brow shape for every type of face. No matter what features the individual possesses, the stencils work with the Golden Ratio and natural bone structure to create an ideal custom brow for every person.*

(Not. Opp. Ex. E (Emphasis Added).) Applicant then displays Applicant's Proposed Mark, clearly intending to show consumers how to use the stencils on the brow. (Not. Opp. Ex. E.) (Notably, this page has since been removed from Applicant's website.)

Moreover, even though Opposer has not yet had the opportunity to conduct discovery, it has found examples of Applicant's use on and inside packaging of Applicant's Proposed Mark (or substantially similar illustrations) to show how its stencils and tweezers should be used:



(See Declaration of David Donahue (“Donahue Decl.”) Exs. A, B.) Opposer is confident that it will find in discovery additional evidence of Applicant’s use of Applicant’s Proposed Mark as an informational tool and other evidence that would tend to show that consumers would not perceive Applicant’s Proposed Mark as source-identifying. Applicant’s transparent attempt to prevent such discovery through this Motion should be rejected.

Opposer has properly alleged that Applicant’s Proposed Mark is an informational illustration that fails to function as a trademark—an allegation that Opposer is confident it will be able to support with additional evidence after discovery. Applicant’s motion for judgment on the pleadings on Opposer’s claims under Sections 1, 2 and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1052 and 1127 must be denied.

C. Opposer States a Claim That Applicant’s Proposed Mark Is Functional and Utilitarian

Applicant’s chief argument to dismiss Opposer’s claim that Applicant’s Proposed Mark is functional is that the functionality doctrine applies only to trade dress. (See Mot. 3-7.) Applicant seeks to buttress this argument with the claim that because Applicant’s Proposed Mark is purportedly a “logo”—an allegation that, as already discussed, is not mentioned in the pleadings—the issue of functionality simply “does not apply.” (Mot. 5.) Applicant further argues, without support, that Opposer’s evidence both that Applicant has claimed the features of the Proposed Mark in patents *and* that others in the beauty and cosmetics industry use similar illustrations is irrelevant. As discussed below, however, Applicant’s view of the law is simply wrong. Because Opposer has alleged facts sufficient to state a claim that Applicant’s Proposed Mark is functional, and since these allegations must be taken as true on this Motion, Applicant’s Motion fails.

1. The Functionality Doctrine Is Not Limited to Trade Dress

Pursuant to Section 2 of the Lanham Act, 15 U.S.C. § 1052(e)(5), a proposed trademark shall be refused registration if it “[c]onsists of *a mark* which . . . comprises any matter that, as a whole, is functional” (emphasis added). As defined in Section 45, “[t]he term ‘mark’ includes any trademark, service mark, collective mark, or certification mark.” 15 U.S.C. § 1127. If Congress thought that only trade dress could be functional, it would have said so in Section 2(e)(5). The Lanham Act therefore clearly and unambiguously prohibits the registration of *marks* that are functional. *Compare* 15 U.S.C. § 1125 (addressing functionality with respect to trade dress).

Leading trademark treatises and decisions of the Board and federal courts all make clear that words and images—as well as trade dress—may be considered functional. For example, in *In re Schwauss*, 217 U.S.P.Q. 361, 362 (T.T.A.B. 1983), the Board affirmed an Examining Attorney’s refusal to register the word FRAGILE (stylized) for labels and bumper stickers based on the rationale “that the labels are sold for the purpose of attachment to other articles so as to indicate the fragility of those articles,” and that the mark was therefore functional for the specified goods. As the Board reasoned in its discussion of functionality, “to allow registration would achieve the absurd result of hampering others in their use of the common word “fragile” on any label designed to be placed on any other object to indicate the fragility of said object.” *Id.* Similarly, in *American Greetings Corp. v. Dan-Dee Imports, Inc.*, the Third Circuit found that “tummy graphics” such as a heart, a four leaf clover or a smiling sun on stuffed animal CARE BEARS were “functional” images because they conveyed an emotional message, which was the professed function of the product. 1 U.S.P.Q.2d 1001, 1006 (3d Cir. 1986); *see also* *Compaq Computer Corp. v. Procom Tech., Inc.*, 37 U.S.P.Q.2d 1801, 1811 (S.D. Tex. 1995) (finding the COMPAQ trademark functional as used in the vendor identification portion of a

hard drive’s firmware, because “[p]art of the actual benefit that a drive purchaser wishes to buy is compatibility with CIM and its prefailure notification feature” and “[t]he use of the word Compaq in the vendor ID position provides this compatibility”); 4 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 7:83 (4th ed. 2014) (noting that words can be “functional” in the traditional utilitarian sense”); *id.* § 7:77 (“[I]t is possible for some purely two-dimensional indicia to be utilitarian.”).

Applicant’s argument to the contrary is incoherent. In short, Applicant seeks to read into the Lanham Act a caveat that is not there that would prohibit a mark (as opposed to trade dress) from being considered functional. In support of this argument, Applicant repeatedly insists that its Proposed Mark is a “logo,” and declares that logos cannot be considered functional. (Mot. 11.) Applicant offers no support for this claim and it is, again, an allegation entirely outside the pleadings that should be disregarded by the Board—particularly since Applicant uses Applicant’s Proposed Mark on packaging (*see* Donahue Decl. Ex. A), thus raising the possibility that it is, in fact, trade dress. In any event, whether Applicant’s Proposed Mark is a logo or not is entirely immaterial to the question of functionality. The Proposed Mark is not the Nike “swoosh” symbol, as Applicant might imagine it to be. Rather, as discussed below, it is an illustration that serves a functional, didactic purpose and cannot be registered as a trademark.

2. Opposer Has More Than Sufficiently Alleged That Applicant’s Proposed Mark Is Functional

As noted *supra*, the Lanham Act provides that a proposed mark may be refused registration if it “comprises any matter that, as a whole, is functional.” 15 U.S.C. §1052(e)(5). At its core, the functionality doctrine serves as a balance between trademark and patent law. As the Supreme Court has explained:

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm’s reputation, from instead inhibiting legitimate

competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, 35 U.S.C. §§ 154, 173, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever.

Qualitex Co. v. Jacobson Products Co., 514 U.S. 159, 164-65, 34 U.S.P.Q.2d 1161, 1163 (1995).

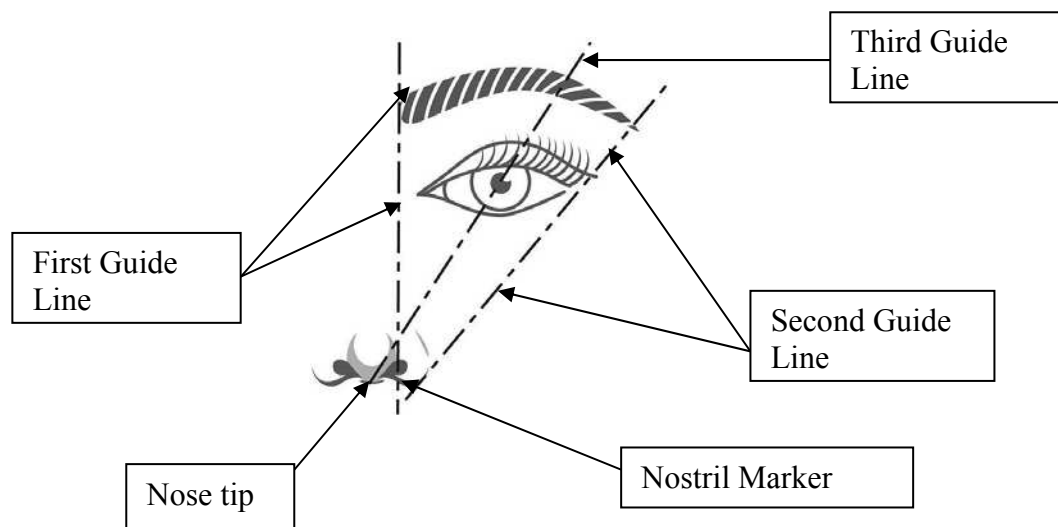
Given this connection between the functionality doctrine and patent law, the Federal Circuit looks at multiple patent-related factors when it considers the issue of functionality, including (1) the existence of a utility patent disclosing the utilitarian advantages of the alleged mark; (2) advertising materials in which the originator of the alleged mark touts the mark's utilitarian advantages; and (3) the availability to competitors of functionally equivalent designs. *See In re Morton-Norwich Prods., Inc.*, 213 U.S.P.Q. 9, 15 (C.C.P.A. 1982). Opposer has pleaded allegations supporting a finding of functionality under each of these factors. Since Opposer's allegations must be taken as true, Applicant's Motion must be denied.

The Supreme Court has observed that "a utility patent is strong evidence that the features claimed therein are functional." *TrafFix Devices Inc. v. Mktg. Displays Inc.*, 532 U.S. 23, 29, 58 U.S.P.Q.2d 1001, 1005 (2001). Here, as alleged in the Notice of Opposition, Anastasia Soare, Applicant's founder and President, owns three patents and two pending patent applications (together, "the Patents") for products and methods relating to brow shaping, each of which discloses and describes a product or method of shaping eyebrows exactly conforming to the diagram that comprises Applicant's Proposed Mark. (*See* Not. Opp. ¶ 18.)

For example, as set forth in the Notice of Opposition, Soare's U.S. Patent No. 8,505,552 (the "552 Patent") claims an invention related to "cosmetic devices, and in particular to eyebrow shaping techniques and related devices," and discloses the invention in the following manner:

[o]ne embodiment of a device in accordance with the present disclosure includes an overlay adapted to be superimposed over an image of a person's face. This overlay has a transparent first portion separated from an opaque second portion by a vertical edge, a nostril marker on the transparent first portion, and a mark centered along the edge indicating placement of a nose tip centered along the edge. *The overlay has a first straight guide line in the first portion passing vertically through the nostril marker, a second straight guide line in the first portion at an angle from the first line passing through an outer edge of the nostril marker, and a third straight guide line at an angle from the first line and spaced from the second line passing through the mark indicating the nose tip.*

(See Not. Opp. ¶¶ 18-20 & Ex. D (emphasis added).) The '552 Patent further discloses that, in an exemplary overlay, the corresponding First Guide Line defines where the eyebrow begins; the Second Guide Line passes from the side of the nostril past the outer edge of the eye, showing the ideal endpoint of the eyebrow; and the Third Guide Line “should ideally” pass from the nose tip through the iris and intersect at the highest point of the eyebrow. The Patent concludes that application of all the foregoing guide lines to a facial image make the proportions of the eyebrow correspond to a “Golden Ratio.” (See Not. Opp. Ex. D.) As shown below, the visual orientation of the guidelines with the eye, nose and eyebrow in Applicant's Proposed Mark is the literal equivalent of what the '552 Patent discloses and claims as Soare's invention:



Similarly, in each of Soare's other patents and patent applications—U.S. Patent No. 8,015,981 “Stencils and gauging device for aesthetically pleasing eyebrow shaping”; U.S. Patent

No. 8,342,190 “Stencils and gauging device for aesthetically pleasing eyebrow shaping”; U.S. Patent Application No. 13/692,804 “Method of Using an Eyebrow Stencil Holder”; and U.S. Patent Application No. 13/692,768 “Eyebrow Stencil Holder”—the inventor describes the invention as follows, in pertinent part:

[T]he inventor has determined that on a “perfect” face, the High Point (“HP”) of the eyebrow arch between its Starting Point (“SP”) adjacent the nose and its End Point (“EP”) adjacent the temple would divide the eyebrow arch at precisely the Golden Ratio point between the SP and the EP (SP-to-HP divided by HP-to-EP= ϕ). The inventor has also observed that *when the SP is on an imaginary guide line running vertically through the middle of the respective nostril, the EP on a second imaginary guide line running from the outer edge of the nostril through the outside end of the eye and the HP is located on an intermediate imaginary guide line extending from the center of the nose through the iris at the center of a woman’s eye, there is an optimal match between her eyebrows and her other facial features.*

(Not. Opp. Ex. D (emphasis added).) This description, again, is the literal equivalent of Applicant’s Proposed Mark.

As alleged in the Notice of Opposition, the Patents disclose the utilitarian advantages of Applicant’s Proposed Mark, and claim the same as an underlying feature of each of the inventions. (*See, e.g.*, Not. Opp. ¶¶ 20-22.) These Patents make it abundantly clear that, at a minimum, utilitarian concerns dictate the overall design of Applicant’s Proposed Mark. On this basis alone, registration of Applicant’s Proposed Mark must be denied.

Contrary to Applicant’s arguments, Opposer’s Notice of Opposition also alleges facts satisfying the other *Morton-Norwich* factors. First, as Opposer alleged, Applicant has repeatedly touted the utilitarian advantages of Applicant’s Proposed Mark in its advertising materials. (*See* Not. Opp. ¶ 24 & Ex. E.) As shown in Exhibit E to the Notice of Opposition, Applicant’s Proposed Mark appeared on Applicant’s website immediately below the following description:

Anastasia discovered the easiest way to balance every face was through applying the Golden Ratio to the brows. *Her signature technique calculates the exact starting and ending points in conjunction with the ideal arch for each individual*

face. These three points are the first step in creating symmetry and proportion in the features. Following her dream to make this system accessible for everyone, Anastasia created a set of five patented Stencils that demonstrate the ideal brow shape for every type of face. No matter what features the individual possesses, the stencils work with the Golden Ratio and natural bone structure to create an ideal custom brow for every person.

"The Golden Ratio technique uses the eye brow as the starting point for beauty. Properly proportioned eyebrows frame the entire face and help bring balance and symmetry to all of your features."



(Not. Opp. Ex. E (emphasis added).) Here, as in *In re Adams Mfg. Corp.*, “[t]he fact that applicant’s own advertising flaunts the utilitarian features of the design sought to be registered supports a finding that there is a competitive need to copy the design and that the design is *de jure* functional.” Serial No. 85/025,503, 2012 WL 3561625, at *4 (T.T.A.B. Aug. 7, 2012).

Finally, registration to Applicant of Applicant’s Proposed Mark would cause a significant non-reputation-related disadvantage to Opposer and others in the beauty and cosmetics industry. (Not. Opp. ¶ 26.) Many of Applicant’s competitors in the cosmetics industry use similar diagrams as a pedagogical tool for mapping and shaping eyebrows, and have been doing so since long before Applicant’s claimed date of first use. (Not. Opp. ¶ 13.) Opposer’s brow grooming and shaping services and products are a core part of its business (*see* Not. Opp. ¶ 6), and being unable to display such brow-mapping diagrams and illustrations on packaging and promotional materials for its products and services for fear that Applicant will assert that such use infringes Applicant’s Proposed Mark would cause significant harm to Opposer (*see* Not. Opp. ¶ 32).

D. Opposer Amply States a Claim That Applicant's Proposed Mark Is Descriptive

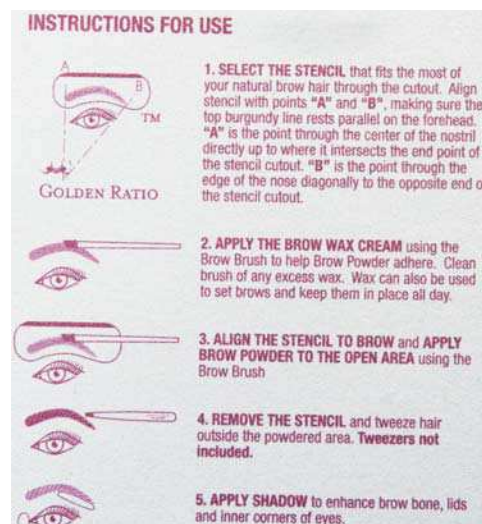
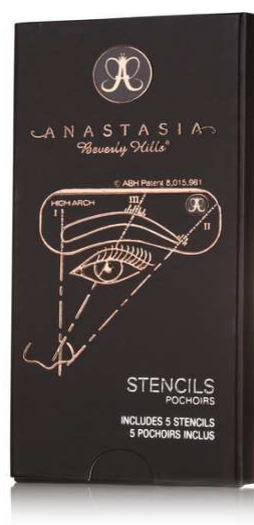
It is axiomatic that a term is merely descriptive of goods or services if it conveys information concerning any significant ingredient, quality, characteristic, feature, subject matter, *function, purpose, or use* of the goods or services. *See, e.g., In re Gyulay*, 3 U.S.P.Q.2d 1009, 1010 (Fed. Cir. 1987); *In re Abcor Dev. Corp.*, 200 U.S.P.Q. 215, 218-19 (C.C.P.A. 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a “significant function or attribute or property of the goods.” *In re H.U.D.D.L.E.*, 216 U.S.P.Q. 358, 359 (T.T.A.B. 1982); *see In re Away Chem. Corp.*, 217 U.S.P.Q. 275, 275-76 (T.T.A.B. 1982).

As alleged in the Notice of Opposition, Applicant's Proposed Mark is merely a descriptive diagram that describes Applicant's method for mapping eyebrows. (Not. Opp. ¶ 29.) In other words, Applicant's Proposed Mark clearly describes the use and function of the goods set forth in Applicant's Applications: namely, the mapping and shaping of eyebrows with stencils and tweezers.

Contrary to Applicant's apparent argument, it is not necessary for a finding of descriptiveness that Applicant's Proposed Mark describe the product for which Applicant seeks to register the mark. (*See* Mot. 9.) Instead, as the Board noted in *Away Chemical*, it is sufficient for a finding of descriptiveness that the mark conveys in clear shorthand information how to use the goods set forth in the Applications for mapping and grooming eyebrows. *See In re Away Chem.*, 217 U.S.P.Q. at 276; *see also In re Platinum Tech., Inc.*, Serial No. 75/051,527, 1999 WL 180771, at *2 (T.T.A.B. Mar. 31, 1999) (affirming refusal to register on descriptiveness grounds because “[w]hen the mark in the instant application is considered in conjunction with

the goods identified therein, it is clear that the mark conveys specific information about the function or purpose of the goods”).

Likewise, and also contrary to Applicant’s claims, it is unnecessary that Applicant’s Proposed Mark be an “illustration” of the recited goods themselves to be considered descriptive. (See Mot. 9.) As the Board observed in *In re Underwater Connections, Inc.*, 221 U.S.P.Q. 95, 95 (T.T.A.B. 1983), an alleged mark that consists of a “descriptive representation of a product in use” is equally as void for descriptiveness as a depiction of the product itself. *See id.* (refusing registration to a proposed mark consisting of a stylized drawing of a compressed gas tank used in diving for “travel tour services involving underwater diving”); *In re Eight Ball Inc.*, 217 U.S.P.Q. 1183, 1183-84 (T.T.A.B. 1983) (refusing registration to a mark consisting of a cue stick and an eight ball for billiard parlor and/or arcade services, because the mark was a pictorial representation of items commonly used in the course of participating in the services). As in these cases, Applicant’s Proposed Mark should be denied registration because it depicts the use, purpose or function of Applicant’s products. Indeed, even without the benefit of discovery, Opposer has learned that Applicant has used Applicant’s Proposed Mark (or substantially similar illustrations) to illustrate how the products identified in the Applications should be used:



(See Donahue Decl. Exs. A, B.) Opposer expects to find additional evidence to support its descriptiveness claim once it is permitted to proceed with discovery.

In sum, Opposer has easily met the liberal standards for pleading its descriptiveness claim and is confident that it will be able to prove its claim that Applicant's Proposed Mark merely depicts the use, purpose, or function of Applicant's Proposed Mark and must be denied registration.¹ Accordingly, Applicant's Motion for judgment on the pleadings on grounds of descriptiveness must be denied.


IV. CONCLUSION

For all the reasons stated above, Opposer has more than sufficiently alleged that Applicant's Proposed Mark fails to function as a mark and is functional and descriptive. As such, Applicant's motion for judgment on the pleadings should be denied.

Dated: New York, New York
September 23, 2014

Respectfully submitted,

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¹ While Opposer submits that its Notice of Opposition easily meets the notice pleading standard under Federal Rule of Civil Procedure 8(a) and Trademark Rule of Practice 2.104(a), to the extent that the Board would otherwise dismiss Opposer's descriptiveness claim as insufficiently pleaded, Opposer would request that the Board grant it leave to amend the Notice of Opposition to add the images shown in Exhibits A and B to the Declaration of David Donahue as exhibits and to state as follows: "Applicant's Proposed Mark is merely a descriptive diagram that describes a use, function, or purpose of the goods set forth in Applicant's Applications; namely, 'Tweezers' in International Class 8, and 'Stencils for use in applying makeup and shaping the eyebrow' in International Class 16." See Donahue Decl. ¶¶ 3-5; see also *Boral Ltd. v. FMC Corp.*, 59 U.S.P.Q.2d 1701, 1702 (T.T.A.B. 2000) ("The Board liberally grants leave to amend pleadings at any stage of the proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party.").

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing is being served by electronic mail upon Applicant's counsel at the following addresses:

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this 23rd day of September 2014.



David Donahue